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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,795	08/24/2000	Robert Wallach	4090-4003	3916

7590 06/25/2003

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/645,795

Applicant(s)

WALLACH ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08/24/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 08/24/00. Claims 1-4 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technology arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. More ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve use, or advance the technological arts to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Looking at claims 1-4 as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps.

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Examiner notes that the common usage of terms such as "a computer readable-medium" or a "computer system" are well taken to be within the statutory categories within 35 U.S.C.101 and therefore recommends using such terminologies.

As such, the above deficiencies may be cured by simply explicitly reciting that the claimed method/process steps are embodied or implemented on a "computer system" or on a "computer readable-medium (as appropriate), provided Applicant show proper support for such recitations in the originally filed specification.

#### Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (6,347,302) in view of Bell et al (6,574,606).

(A) As per claim 1, Joao discloses identifying a lease on an item, the lease having an approaching expiration date (Col.14, lines 29-67);

identifying a customer corresponding to the lease (Col.11, lines 43-67).

Joao does not explicitly disclose a method for encouraging the purchase or re-leasing of an item after an expiration of a lease, and

offering the customer a paid insurance policy in exchange for purchasing or re-leasing the item after the expiration date;

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Joao does not explicitly disclose a method for encouraging the purchase or re-leasing of an item after an expiration of a lease, and

offering the customer a paid insurance policy in exchange for purchasing or re-leasing the item after the expiration date.

However, this feature is known in the art, as evidenced by Bell. In particular, Bell suggests a method for encouraging the purchase or re-leasing of an item after an expiration of a lease, and

offering the customer a paid insurance policy in exchange for purchasing or re-leasing the item after the expiration date (Col.3, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Bell within the system of Joao with the motivation of providing customer loyalty programs or add-on service programs. Such services enhance profitability by providing increased revenue on each sale (See Bell, Col.1, lines 32-40).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (6,347,302) in view of Ryan et al (6,304,859).

(A) As per claim 2, Joao discloses a method for encouraging the purchase or re-leasing of an item after an expiration of a lease, comprising:

identifying a customer having a lease on an item, the lease having an approaching expiration date (Col.1, lines 6-65; Col.14, lines 29-67);

determining a term for an insurance policy, the insurance policy having an insurance premium at most equal top the difference (Col.7, lines 66-67 to Col.8, line 67).

Joao does not explicitly disclose calculating a difference between an actual residual value and a projected residual value of the item; and

if the customer purchases or re-leases the item at the expiration of the lease, paying the insurance premium on behalf of the customer for the term of the insurance policy.

However, these features are known in the art, as evidenced by Ryan. In particular, Ryan suggests calculating a difference between an actual residual value and a projected residual value of the item (Col.6; lines 5-67) and

if the customer purchases or re-leases the item at the expiration of the lease, paying the insurance premium on behalf of the customer for the term of the insurance policy (Col.6, lines 5-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Ryan within the system of Joao with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan Col.5, lines 16-19).

(B) As per claim 3, Joao discloses a method for receiving an insurance policy for an item, comprising :

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leasing an item for a predetermined period of time;  
purchasing the item at the expiration of the predetermined period of time (Col.13, lines 34-67 to Col.14, line 65).

Joao does not explicitly disclose receiving an insurance policy for an item, wherein at least a portion of the premium corresponding to the insurance policy is paid by a third party.

However, these features are known in the art, as evidenced by Ryan. In particular, Ryan suggests receiving an insurance policy for an item, wherein at least a portion of the premium corresponding to the insurance policy is paid by a third party (Col.4, lines 22-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Ryan within the system of Joao with the motivation of providing a system performing three processes which ideally occur simultaneously, namely, 1) optimal premium determination, 2) current cash value monitoring, and 3) periodic reporting (See Ryan Col.5, lines 16-19).

(C) As per claim 4, Joao discloses the method wherein said purchasing comprising re-leasing the item (Col.1, lines 6-67).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited not applied art teaches insurance verification system and method (6,233,563), motor vehicle monitoring system for determining a cost of

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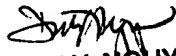
insurance (5,797,134), method and apparatus for internet on-line insurance policy service (2002/0116228), system and method for real-time rating, underwriting and policy issuance (2002/0091550) and system and method for facilitating transfer of vehicle leases.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F  
V.F  
June 18, 2003

  
DINH X. NGUYEN  
PRIMARY EXAMINER